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Joyce Tom



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Date: September 10, 2001

David W. HILL et al.

Serial No.: 09/335,201

Group Art Unit: 2835

Filed: June 17, 1999

Examiner: Vortman, A.

For: PC KEYBOARD WITH DETACHABLE SMARTCARD SECURITY DEVICE

Assistant Commissioner of Patents
Washington, D.C. 20231

APPEAL BRIEF TRANSMITTAL LETTER

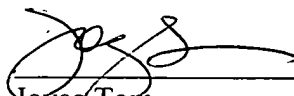
Sir:

Submitted herewith are an original and two copies of an Appellant's Brief on Appeal under 37 C.F.R. § 1.192 in connection with the above-referenced Patent application. The Brief includes an Appendix A. Also, enclosed is an Associate Power of Attorney.

Please charge the Appeal Brief filing fee of **\$ 310.00** to Deposit Account No. 50-0563 (IBM Corporation). A duplicate of this sheet is attached.

Respectfully submitted,

September 10, 2001
Date


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Attorney Docket: RP999082/1978P

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Robert
Appellant
Brief
1 of 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPEAL NO: To Be Assigned

In Re Application of: David W. HILL et al.

Serial No: 09/335,201

Filed: June 17, 1999

For: PC KEYBOARD WITH DETACHABLE SMARTCARD SECURITY DEVICE

APPELLANT'S BRIEF

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I. REAL PARTY IN INTEREST

II. RELATED APPEALS AND INTERFERENCES

III. STATUS OF CLAIMS

IV. STATUS OF AMENDMENTS

V. SUMMARY OF THE INVENTION

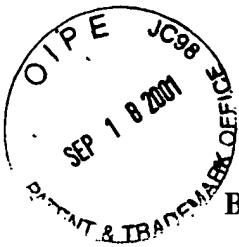
VI. ISSUES

VII. GROUPING OF CLAIMS

VIII. ARGUMENTS

- A. Summary of the Applied Rejection
- B. The Cited Prior Art
- C. Claims 1-10 are Allowable Over Knights
- D. Claims 9-12 are Allowable Over Arney
- E. Summary of Arguments

IX. APPENDIX



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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APPELLANT'S BRIEF ON APPEAL

Sir:

Appellant herein files an Appeal Brief drafted in accordance with the provisions of 37
C.F.R. § 1.192(c) as follows:

I. REAL PARTY IN INTEREST

Appellants respectfully submit that the above-captioned application is assigned, in its
entirety to International Business Machines Corporation, of Armonk, New York.

II. RELATED APPEALS AND INTERFERENCES

Appellants state that, upon information and belief, they are not aware of any co-pending
appeal or interference which will directly affect or be directly affected by or have a bearing on
the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-12 are pending in the present application and stand rejected. Originally, claims 1-10 were pending in the application, as filed. Claims 1, 6, and 7-10 were amended and claims 11-14 added in an Amendment dated December 19, 2000. Claims 13 and 14 were cancelled in a Final Amendment. Accordingly, Claims 1-12 are on appeal and all applied rejections concerning those claims are herein being appealed.

IV. STATUS OF AMENDMENT

All amendments have been entered.

V. SUMMARY OF THE INVENTION

The present invention is directed to a personal computer (PC) accessory unit which can be attached to, and detached from, a standard stand alone PC keyboard. In a preferred embodiment of the present invention, the accessory unit includes a body structure coupled to a connecting assembly. The body structure is designed to hold and protect a PC card, such as a SmartCard, so that the user does not misplace the card or otherwise damage it. The PC accessory unit is directly attached to the stand alone keyboard via the connecting assembly. Thus, the user's PC card is kept and protected in the PC accessory unit in close proximity to the user. (Specification, page 2, lines 11-15).

In the preferred embodiment of the present invention, the connecting assembly includes a clip. The backside of the keyboard, i.e., the side facing away from the user, is configured to receive the clip, so that the PC accessory unit clips into the backside of the keyboard.

The present invention, as recited in claims 1, 6, 9 and 10, provide:

1. A PC accessory unit for use with a desktop personal computer assembly including a PC keyboard, the PC keyboard being a stand alone component, the PC accessory unit comprising:

a body structure incorporating electronic circuitry for operation with a PC;
and

a connecting assembly coupled to the body structure for attaching the body structure externally to the PC keyboard.

6. A PC accessory unit for use with a stand alone PC keyboard, comprising:

a body structure incorporating electronic circuitry for operation with a PC;

a connecting assembly coupled to the body structure;

wherein the connecting assembly is coupled externally to the PC keyboard.

9. A PC accessory unit, comprising:

a body structure incorporating electronic circuitry for operation with a PC;

a connecting assembly, including a clip, coupled to the body structure; and

a keyboard having a backside surface facing away from a user, the keyboard configured to receive the connecting assembly and clip at the backside of the keyboard, such that the body structure is attached externally with the backside of the keyboard, the keyboard being a stand alone component.

10. A PC accessory unit, comprising:

a body structure for holding a device for use with a PC;

a connecting assembly, including a clip, coupled to the body structure; and

a keyboard having a backside surface facing away from a user, the keyboard configured to receive the connecting assembly and clip at the backside of the keyboard, such that the body structure is attached externally with the backside of the keyboard, the keyboard being a stand alone component.

VI. ISSUES

The issue presented is:

1. Whether claims 1-10 are anticipated by Knights (U.S. Patent No. 5,752,857) (Knights) under 35 U.S.C. § 102(b).

2. Whether claims 9-12 are anticipated by Arney et al. (U.S. Patent No. 4,749,364) (Arney) under 35 U.S.C. §102(b).

VII. GROUPING OF CLAIMS

Appellant hereby states that claims 1-8, 11 and 12 form one group. Claim 9 forms a second group, and claim 10 forms a third group.

VIII. ARGUMENTS

A. Summary of the Applied Rejections

In the Final Office Action, the Examiner rejected claims 1-10 under 35 U.S.C. §102(b) as being anticipated by Knights (U.S. Patent No. 5,752,857) (Knights). Moreover, the Examiner rejected claims 9-12 under 35 U.S.C. §102(b) as being anticipated by Arney et al. (U.S. Patent No. 4,749,364) (Arney).

In rejecting independent claims 1 and 6, the Examiner stated:

Regarding claim 1, Knights disclosed, (Fig. 7), a PC accessory unit for use with a desktop personal computer assembly including a PC keyboard (10), the PC accessory unit comprising: a body structure (180) incorporating electronic circuitry (30) for operation with a PC; and a connecting assembly (84A, 92) coupled to the body structure for attaching body structure externally to the PC keyboard (10).

Regarding claim 6, Knights disclosed, (Fig. 7), a PC accessory unit for use with a PC keyboard (10), comprising: a body structure (180) incorporating electronic circuitry (30) for operation with a PC; a connecting assembly (84A, 92) coupled to the body structure (180); wherein the connecting assembly is coupled externally to the keyboard.

Final Office Action, p. 3.

B. The Cited Prior Art

1. *Knights* (U.S. Patent No. 5,752,857)

Knights is directed to a Smartcard computer *adapter*, which allows a user to utilize the Smartcard via the computer's IC card slot. The adapter receives a Smartcard at one end, and at the other end, connects with a standard IC card, which is inserted into the computer's IC card

slot. In Figure 7 of Knights, the adapter (180) is illustrated in relation to the Smartcard (30), the computer (10) having a IC card slot (12), and the IC card (14A) inserted therein. As is shown, the adapter (180) attaches *to the IC card* (14A) by inserting the adapter plug (84A) into the IC card receptacle (82A) (Col. 4, lines 50-52).

2. *Arney* (U.S. Patent No. 4,749,364)

Arney is directed to an attachment apparatus that allows a user to attach and detach a display monitor to a portable computer. As is shown in Figure 1 of *Arney*, the LCD display 105 includes two plugs 107 which are received by sockets 103 in the portable computer 101. One of the sockets 103 includes an electrical connector, such that when the display 105 is connected to the portable computer 101, power and electrical signals are provided to the display 105, i.e., the display becomes operable. (Col. 3, lines 1-27).

C. Claims 1-10 are Allowable Over Knights

1. The Knights Adapter is Not Attached *Externally* to the Keyboard.

Applicants respectfully submit that Knights fails to teach or suggest the present invention, as recited in claims 1, 6, 9 and 10. In particular, Knights fails to teach or suggest “a connecting assembly coupled to the body structure for attaching the body structure *externally to the PC keyboard*,” as recited in claim 1, or “a keyboard, wherein the connecting assembly is coupled *externally to the keyboard*,” as recited in claim 6, or “a keyboard, . . . the keyboard configured to receive the connecting assembly . . . such that the body structure is attached *externally* with the . . . keyboard,” as recited in claims 9 and 10.

In Knights, the adapter is electrically and mechanically connected to the *IC card*, via the

socket contacts and adapter plug. The adapter *is not* attached *externally* to the computer because the IC card is inserted *into* the computer. The IC card and, indirectly, the adapter are attached *internally* to the computer, i.e., the IC card is electrically and mechanically connected to a component (IC card slot) *inside* the computer. Therefore, the IC card/adapter is not “attached externally” to the keyboard, as recited in claims 1, 6, 9 and 10.

Moreover, the IC card *is not* a part of the computer; rather, it is a removable device that plugs into a computer via an IC card slot. Thus, while the adapter is connected to the IC card, it is not attached *to the computer*. Accordingly, Knights fails to teach or suggest “a connecting assembly coupled to the body structure for attaching the body structure *externally to the PC keyboard*,” as recited in claim 1, or “a keyboard, wherein the connecting assembly is coupled *externally to the keyboard*,” as recited in claim 6, or “a keyboard, . . . the keyboard configured to receive the connecting assembly . . . such that the body structure is attached *externally with the . . . keyboard*,” as recited in claim 9 and 10.

2. The Knights Adapter is Not Attached to the Keyboard.

Nothing in Knights suggests or teaches attaching the body structure to the “PC keyboard,” as recited in claims 1, 6, 9 and 10. In the present invention, the body structure is mechanically attached externally to the keyboard via the connecting assembly. The connecting assembly provides mechanical attachment only, and because it is attached externally, it does not provide an electrical connection to the computer. In Knights, the adapter must be connected *electrically and mechanically* to the IC card, which in turn is inserted into the IC card slot of the computer. The IC card becomes electrically connected to the computer’s processing system via the slot.

Nothing in Knights teaches or suggests that the adapter/IC card can be attached externally *to the keyboard*, as opposed to the IC card slot. Indeed, this would make absolutely no sense

because the IC card would not be able to make electrical contact with the computer if it were attached to the PC keyboard. Without an electrical contact with the computer, Knights' adapter would be useless because the computer would not be able to access the contents of the Smartcard.

3. The Knight Adapter is Not Attached to a *Stand Alone Keyboard*.

Knights' adapter *is not* intended for use with a standard stand alone PC keyboard, as recited in claims 1, 6, 9 and 10. In Knights, the IC card slot into which the IC card is inserted is located on the side of a *computer device*, where electrical contact with the computer is possible. The computer device presumably has the requisite hardware and software to communicate with the IC card, and is an intelligent device, such as a notebook as illustrated in Figure 1 of Knights. Because the notebook computer *incorporates* a keyboard, the keyboard *is not* a stand alone component.

The stand alone keyboard, as recited in the present invention, is a standard data input device used in a desktop environment. The standard keyboard generally has an electrical cord that connects to a port in the computer. It does not include memory or a processor. It merely allows the user to communicate (entering data or commands) with the computer. Unlike the computer device of Knights, the stand alone keyboard does not have the capability to communicate with the body structure. After all, the body structure is only *externally* attached to the keyboard. Accordingly, Knights fails to teach or suggest "attaching the body structure externally to the PC keyboard," "the keyboard being a stand alone component," as recited in claims 1, 6, 9 and 10.

For reasons discussed above, Knights fails to teach or suggest the present invention, as recited in claims 1, 6, 9 and 10. Therefore, Applicants respectfully submit that claims 1, 6, 9 and

10 are allowable over Knights. Claims 2-5, and 7-8 depend on claims 1 and 6 respectively and the above arguments apply with equal force to these claims. Accordingly, Applicants respectfully submit that claims 2-5 and 7-8 are also allowable over Knights.

D. Claims 9-12 are Allowable Over Arney

As stated above, independent claims 9 and 10 are similar in scope to claims 1 and 6. Claims 9 and 10, however, also recite that the “connecting assembly and clip [is attached] at the backside of the keyboard.” The keyboard’s backside is a “surface facing away from a user.”

Arney fails to teach or suggest “a keyboard, . . . the keyboard configured to receive the connecting assembly . . . such that the body structure is attached *externally* with the . . . keyboard,” as recited in claims 9 and 10. As stated above, the present invention provides that the body structure is attached externally to the keyboard. In Arney, the display 105 is plugged *into* the portable computer 101 via the sockets 103, i.e., the display 105 is attached *internally* to the computer 101. Thus, the display *is not* “attached externally” to the keyboard, as recited in claims 9 and 10.

Moreover, Arney does not teach or suggest attaching the display to the “keyboard, the keyboard being a stand alone component,” as recited in claims 9 and 10. Rather, in Arney, the display is mechanically and electrically connected to the *portable computer* 101, not the keyboard. Attaching Arney’s display to *the keyboard* would make no sense because the display would not be able to make electrical contact the computer if it were attached to the keyboard. Without electrical contact with the computer, the display would be useless because it would not receive power and signals from the computer.

Furthermore, Arney’s display *is not* intended for use with a standard stand alone PC

keyboard, as recited in claims 9 and 10. Arney's display must be connected to a *computer*, such as the portable computer illustrated in Figure 1. Because the portable computer incorporates a keyboard, the keyboard *is not* a stand alone component. Accordingly, Arney fails to teach or suggest "a keyboard . . . configured to receive the connecting assembly and clip . . . , such that the body structure is attached externally with the . . . keyboard, the keyboard being a stand alone component," as recited in claims 9 and 10.

For reasons discussed above, Arney fails to teach or suggest the present invention, as recited in claims 9 and 10. Therefore, Applicants respectfully submit that claims 9 and 10 are allowable over Arney.

Claims 11 and 12 depend on independent claim 6. Like claims 9 and 10, claim 6 recites the features that distinguish claims 9 and 10 from Arney. Therefore, the arguments above relating to claims 9 and 10 apply with full force to claim 6, and in turn, to claims 11 and 12. Thus, Applicants respectfully submit that claims 11 and 12 are allowable over Arney.

E. Summary of Arguments

For the reasons set forth above, Appellants respectfully submit that the present invention, as recited in independent claims 1, 6, 9 and 10, is not taught or suggested by the cited references. Claims 1, 6, 9 and 10 are therefore allowable. Claims 2-5, 7-8, 11 and 12 depend from independent claims 1 and 6, respectively, and consequently the arguments herein apply with equal force and effect to dependent claims 2-5, 7-8, 11 and 12. Accordingly, Appellants respectfully submit that claims 2-5, 7-8, 11 and 12 are also allowable over the cited references.


Appellant respectfully requests that the final rejection of claims 1-12 be reversed.

Note: For convenience of detachment without disturbing the integrity of the remainder of pages of this Appeal Brief, Appellant's APPENDIX A is attached separately following the signatory portion of this Appeal Brief.

This Appeal Brief is being submitted in triplicate, and authorization for payment of the required Appeal Brief fee is contained in the cover letter for this brief. Please charge any fee that may be necessary for the continued pendency of this application to Deposit Account No. 50-0563 (IBM Corporation).

Very truly yours,

September 10, 2001
Date



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IX. APPENDIX A

1. (Once Amended) A PC accessory unit for use with a desktop personal computer assembly including a PC keyboard, the PC keyboard being a stand alone component, the PC accessory unit comprising:

a body structure incorporating electronic circuitry for operation with a PC; and
a connecting assembly coupled to the body structure for attaching the body structure externally to the PC keyboard.

2. The PC accessory unit as defined in Claim 1, wherein the connecting assembly is a clip for attachment to a PC keyboard.

3. The PC accessory unit as defined in Claim 2, wherein the clip has two prongs for insertion into openings in a PC keyboard.

4. The PC accessory unit as defined in Claim 3, wherein the accessory unit is a Smartcard utility kit.

5. The PC accessory unit as defined in Claim 4, wherein the clip of the Smartcard utility kit is inserted into keyboard openings.

6. (Once Amended) A PC accessory unit, comprising:

a body structure incorporating electronic circuitry for operation with a PC;

a connecting assembly coupled to the body structure; and
a key board, wherein the connecting assembly is coupled externally to the keyboard, the keyboard being a stand alone component.

7. (Once Amended) A PC accessory unit, as defined in claim 6, wherein the body structure is a Smartcard utility kit.

8. (Once Amended) A PC accessory unit, as defined in Claim 7, wherein the connecting assembly is a clip for attachment to the keyboard.

9. (Once Amended) A PC accessory unit, comprising:
a body structure incorporating electronic circuitry for operation with a PC;
a connecting assembly, including a clip, coupled to the body structure; and
a keyboard having a backside surface facing away from a user, the keyboard configured to receive the connecting assembly and clip at the backside of the keyboard, such that the body structure is attached externally with the backside of the keyboard, the keyboard being a stand alone component.

10. (Once Amended) A PC accessory unit, comprising:
a body structure for holding a device for use with a PC;
a connecting assembly, including a clip, coupled to the body structure; and
a keyboard having a backside surface facing away from a user, the keyboard configured to receive the connecting assembly and clip at the backside of the keyboard, such that the body

structure is attached externally with the backside of the keyboard, the keyboard being a stand alone component.

11. The PC accessory unit as defined in Claim 8, wherein the keyboard has a plurality of openings for receiving the clip.

12. The PC accessory unit as defined in claim 11, wherein at least one opening of the plurality of openings is located at a backside of the keyboard, the backside being a surface facing away from a user.